

## **REMARKS**

### **Claim Rejections**

Claims 17, 20, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over admitted prior art (admission) in view of Yarita et al. (U.S. Patent No. 6,411,353). Claims 18 and 19 are rejected under 35 U.S.C §103(a) as being unpatentable over admitted prior art in view of Yarita et al., and further in view of Levanon (U.S. Patent No. 6,855,411).

Claims 1 and 4-16 are allowed.

Claims 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Amendments to Specification**

Applicant has amended the Specification as noted above to provide proper antecedent basis in the specification for "the surface area of the conductive film is smaller than that of the printed circuit board" that is illustrated in Figs. 3B, 4A, and 4D as originally filed in this application. No "new matter" has been added to the original disclosure by the foregoing amendments to the Specification.

### **New Claims**

By this Amendment, Applicant has canceled claims 17-22 and has added new claims 23-28 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

New claim 23 includes the limitation shown in Figs. 3B, 4A, and 4D: "the surface area of the conductive film is smaller than that of the printed circuit board". Support for this limitation may be also found in the amended paragraphs [0024], [0026], and [0030]. No new matter has been introduced by this amendment.

The claims 18-22 have been written as new claims 24-28 depending from new claim 23.

The primary reference to Yarita et al. teaches the surface area of the conductive film (MTP) is greater than that of the printed circuit board (FPC2) [FIG. 1]. Whereas, new claim 23 of the present invention includes the limitation that is opposite to what Yarita et al teaches. Accordingly, it is apparently hard for one skilled in the art to be stimulated from the teaching of Yarita et al. to design such a mechanism as claimed in claim 23 of the present invention.

Even if the teachings of Yarita et al., Applicant's admitted prior art, and Levanon were combined, as suggested by the Examiner, the resultant combination does not suggest: a surface area of the conductive film being substantially smaller than that of the printed circuit board.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Yarita et al., Applicant's admitted prior art, or Levanon that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Yarita et al., Applicant's admitted prior art, nor Levanon disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Claims 1 and 4-16 are allowed.

Application No. 10/790,812

**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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